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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,079	12/12/2001	Yutaka Hasegawa	SUZU:002	6932

7590

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EXAMINER

BOVEJA, NAMRATA

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/016,079	Applicant(s) HASEGAWA, YUTAKA	
	Examiner Namrata Boveja	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/07/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-16 are presented for examination.

Objections

2. Claims 1, 5, 9, and 13 are objected to due to the following informalities.

The claims recite "advertisers who subscribe the information service," and the claim should be corrected to recite "advertisers who subscribe **to** the information service." Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless – (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 4-6, 8-10, 12-14, and 16, are rejected under 102(e) as being anticipated by Yamanaka et al. (Publication Number US 2001/0016834 A1 hereinafter Yamanaka).

In reference to claims 1, 5, 9, and 13, Yamanaka discloses the method, system, a machine-readable medium, and a computer program for managing an information service, which handles distribution of digital contents and presentation of advertising messages to users over a computer network (abstract and page 1 paragraphs 12-16), the system comprising: a first database

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containing advertising messages provided from advertisers (page 1 paragraph 16, page 6 paragraph 117, page 10 paragraph 181, page 15 paragraphs 258, 263, and 264, page 16 paragraphs 271-273, and Figures 4, 5, 14, 15, 23, and 27), who subscribe to the information service with payment of advertisement fees (page 1 paragraph 17, page 2 paragraph 25, page 9 paragraph 153, page 11 paragraph 184, and page 12 paragraph 198); a second database containing a plurality of digital contents which are subject to legal protection on behalf of content proprietors (page 1 paragraph 16, page 2 paragraph 24, page 4 paragraphs 60 and 67, page 15 paragraphs 258 261, and 262, page 16 paragraphs 284-286, and Figures 23, 27, and 28); a presenting section that presents the advertising messages over the computer network to the users who use the information service (page 7 paragraph 119, page 9 paragraph 162, page 15 paragraphs 263 and 264, page 16 paragraphs 271-276, and Figures 7 and 8); a distributing section that distributes the digital contents to the users upon request from the users over the computer network (page 6 paragraph 118 to page 7 paragraph 119, page 8 paragraph 134, page 9 paragraph 152, page 15 paragraphs 261-262, and page 16 paragraph 284); and an allocating section that allocates at least a part of the advertisement fees collected from the subscribing advertisers to the content proprietors of the digital contents distributed to the users (page 1 paragraph 17, page 2 paragraph 25, page 4 paragraph 61, page 8 paragraph 142, page 12 paragraph 198 and 200, page 13 paragraph 226, page 20 paragraph 343, and Figure 20).

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4. In reference to claims 2, 6, 10, and 14, Yamanaka discloses the method, system, a machine-readable medium, and a computer program wherein the second database contains protected digital contents subject to legal protection (i.e. content owned by creators and holders excluding distributors that requires the use of an execution key) and non-protected digital contents not subject to legal protection (i.e. content owned by distributors that also may not required the use of an execution key) (page 1 paragraph 16, page 2 paragraph 24, page 4 paragraphs 60 and 67, page 8 paragraphs 136-139, page 15 paragraphs 258 261, and 262, page 16 paragraphs 284-286, and Figures 23, 27, and 28), such that the allocating section allocates the collected advertisement fees to the proprietors (i.e. content creators and holders excluding distributors based on the number of times the content was executed as tracked by the execution key) only when the protected digital contents are distributed to the users (page 1 paragraph 17, page 2 paragraph 25, page 4 paragraph 61, page 8 paragraphs 142-143, page 12 paragraphs 198 and 200, page 13 paragraph 226, page 20 paragraph 343, and Figure 20).

5. In reference to claims 4, 8, 12, and 16, Yamanaka discloses the method, system, a machine-readable medium, and a computer program wherein the second database contains a multiple of digital contents subject to legal protection on behalf of the same proprietors (i.e. multiple songs by the same artists or from the same CD for which creators and holders own the rights, multiple game titles by the same manufacturer of the game CD's, and multiple movies by the same movie director) (page 1 paragraph 16, page 2 paragraph 24, page 4 paragraphs

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60 and 67, page 7 paragraph 126, page 8 paragraphs 136-139, page 15 paragraphs 258 261, and 262, page 16 paragraphs 284-286, and Figures 7, 8, 23, 27, and 28) such that the allocating section allocates a part of the collected advertisement fees to the same proprietor when any of the multiple of the digital contents is distributed to the users (i.e. pay the proprietors according to each song download on a per song basis regardless if more than one song from the same artist is downloaded or even if the same song is downloaded more than once) (page 1 paragraph 17, page 2 paragraph 25, page 4 paragraph 61, page 7 paragraph 131, page 8 paragraphs 142-143, page 12 paragraph 198 and 200, page 13 paragraph 226, page 20 paragraph 343, and Figure 20).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 7, 11, and 15 are rejected under U.S.C. 103(a) as being unpatentable over Yamanaka in view of Official Notice.

In reference to claims 3, 7, 11, and 15, Yamanaka discloses contributing digital contents and (i.e. receiving contents from a holder) (page 4 paragraph 67) allocating the collected advertisement fees only for registered (i.e. accepted or obtained or under contractual agreement) (page 4 paragraph 67) distributed contents that are under the legal protection as indicated by the use of an

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execution key by these content holders (page 1 paragraph 17, page 2 paragraph 25, page 4 paragraph 61, page 8 paragraphs 142-143, page 12 paragraphs 198 and 200, page 13 paragraph 226, page 20 paragraph 343, and Figure 20).

Yamanaka doesn't specifically teach the use of status information (i.e. presence information for indicating contents subject or not subject to legal protection) indicating whether or not the contributed digital contents are subject to the legal protection and using the status information in allocating advertisement fees to those that are indicated by the status information. Official Notice is taken that it is old and well known to indicate the status information for digital content by graphics arts companies to ensure that the image they use for example in creating an advertisement is not copyrighted and can be used and reproduced without paying royalties to other companies and to keep track of any costs associated with using a copyrighted image in case the company desire to make use of copyright images for a design campaign.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the use of status information indicating if the content is subject to legal protection and registering this information in a database to view a complete list of status information of digital contents in an easy to view manner. Furthermore, it would have been obvious to do this in order to ensure payment to the content holder by the distributor as indicated by the data presented from the execution key associated with a particular content holder for the number of times the content was executed by a user can be made quickly and accurately.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure include the following.

- a) Dwek Patent Number 6,248,946. Teaches a multimedia content delivery system and method.
- b) Gruenwedel, Erik. "PlayJ media player offers marketers ad space." Brandweek. April 17, 2000. Volume 41. Issue 16. Page 58.
- c) M2 Presswire. "NetBeat: NetBeat embraces new technology to pay artists for downloads." August 29, 2000. Page 1. Teaches paying artists for song downloads while the user accesses content for free by watching an ad in a small window.
- d) Business Wire. "Hiwire and Soundom Ink Deal to Generate Revenue From Internet Music; Innovative Advertising Model Will Use Highly Targeted Ads and Hiwire Sales Network to Keep Music Free." September 20, 2000. Pg. 1. Teaches paying consumers to listen to music and use target advertising to generate revenue to compensate recording artists.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

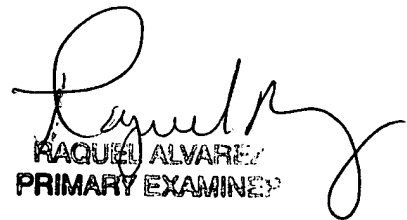
If attempts to reach the examiner by telephone are unsuccessful, the

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examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8105. On July 15, 2005, the Central FAX Number will change to **571-273-8300**. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

NB

February 9th, 2006

RAQUEL ALVAREZ
PRIMARY EXAMINER